Supreme Court, U.S.
FILED
NOV 17 1999
CLERK

No. 99-666

IN THE

Supreme Court of the United States

LRC ELECTRONICS, INC.,

Petitioner,

v.

JOHN MEZZALINGUA ASSOCIATES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

KENNETH J. JUREK
MCDERMOTT, WILL & EMERY
227 West Monroe Street
Chicago, IL 60606-5096
(312) 372-2000

JAMES R. MULDOON
Counsel of Record
HANCOCK & ESTABROOK, LLP
1500 MONY Tower I
P.O. Box 4976
Syracuse, NY 13221-4976
(315) 471-3151

Attorneys for Respondent
John Mezzalingua Associates, Inc.

156266

Counsel Press LLC
FORMERLY LUTZ APPELLATE SERVICES
(800) 274-3321 • (800) 359-6859

STATEMENT PURSUANT TO RULE 29.6

Respondent, John Mezzalingua Associates, Inc., has no parent corporation and no publicly held company owns 10% or more of its stock.

TABLE OF CONTENTS

	Page
Statement Pursuant to Rule 29.6	i
Table of Contents	ii
Table of Cited Authorities	iii
Counter Statement of the Case	1
Reasons for Denying the Writ	3
I. The Limiting Effect Of Prior Art On The Application Of The Doctrine Of Equivalents Is A Question Of Law	3
II. Petitioner Misstates The Law Regarding Wilson Sporting Goods' Hypothetical Claim Analysis	5
Conclusion	9

TABLE OF CITED AUTHORITIES

Page

Cases:

Al-Site Corp. v. VSI International, Inc., 174 F.3d 1308, 1323, 50 U.S.P.Q. 2d 1161 (Fed. Cir. 1999) 5

Athletic Alternatives Inc. v. Prince Manufacturing, Inc., 73 F.3d 1573, 37 U.S.P.Q. 2d 1365 (Fed. Cir. 1996) 3

Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303, 46 U.S.P.Q. 2d 1752 (Fed. Cir. 1998) 7

Ex parte Peterson, 253 U.S. 300, 40 S. Ct. 543, 64 L. Ed. 919 (1920) 4

International Visual Corp. v. Crown Metal Manufacturing Co., Inc., 991 F.2d 768, 26 U.S.P.Q. 2d 1588 (Fed. Cir. 1993) 7

Neely v. Martin K. Eby Construction Co., Inc., 386 U.S. 317, 87 S. Ct. 1072, 18 L. Ed. 2d 75 (1967) 4

Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 4 U.S.P.Q. 2d 1737 (Fed. Cir. 1987) (*en banc*), *cert. denied*, 485 U.S. 961, 108 S. Ct. 1226, 99 L. Ed. 2d 426, 485 U.S. 1009, 108 S. Ct. 1474, 99 L. Ed. 2d 703 (1988) 3

Cited Authorities

Page

Senmed, Inc. v. Richard-Allan Med. Industrial, 888 F.2d 815, 12 U.S.P.Q. 2d 1508 (Fed. Cir. 1989) 7

Stewart-Warner Corp. v. City of Pontiac, Mich., 767 F.2d 15632, 226 U.S.P.Q. 676 (Fed. Cir. 1985) . 7

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S. Ct. 1040, 137 L. Ed. 2d 146 (1997) 3, 4

Wilson Sporting Goods Co. v. David Geoffrey & Assocs., 904 F.2d 677, 14 U.S.P.Q. 2d 1942 (Fed. Cir.), *cert. denied*, 498 U.S. 992, 111 S. Ct. 537, 112 L. Ed. 2d 547 (1990) 2, 3, 5, 6, 7

Statutes:

35 U.S.C. § 103 5

35 U.S.C. § 282 5

Rules:

Fed. Rule Civ. Proc. 50 4

Fed. Rule Civ. Proc. 56 4

COUNTER STATEMENT OF THE CASE

This counter-statement is necessary to correct Petitioner's misstatement of the holding of the Federal Circuit decision in this action.

This is an action for infringement of U.S. Patent No. 4,902,246 ("the '246 patent") assigned to Petitioner and entitled, "Snap-N-Seal Coaxial Connector" asserted against Respondent in the U.S. District Court for the Northern District of New York.

Early during the course of proceedings below, Respondent modified the accused product, to avoid infringement, but Petitioner maintained that both Respondent's original coaxial cable connector, called the CMP1, as well as Respondent's redesigned connector, called the CMP2, infringed claim 1 of the '246 patent. [Appendices to Petition for Writ of Certiorari (hereinafter "App.") at 3a] Respondent denied the substantive allegations of the complaint and counterclaimed for a declaration of noninfringement, invalidity and unenforceability of the '246 patent.

After a ten-day trial, the jury found that the '246 patent was not invalid or unenforceable and the CMP1 connector literally infringed claim 1. These determinations were not challenged on appeal. The jury also found that the CMP2 connector did not literally infringe claim 1; however, the jury found that the CMP2 infringed under the doctrine of equivalents. On February 9, 1998, judgment was entered in accordance with the jury verdict and an injunction issued against further infringement by Respondent. After the denial of its post-trial motions, Respondent appealed, *inter alia*, the finding of infringement under the doctrine of equivalents by the CMP2 connector.

In a non-precedential decision dated May 27, 1999, the Court of Appeals for the Federal Circuit found, after first construing claims language in a means plus function format, that Respondent had replaced the snap engaging ridge-in-groove structure required by the '246 patent with a simple "press fit." [App. at 7a] At trial, Petitioner's own expert witness acknowledged that press fits were well known in the prior art of connectors before the invention claimed in the '246 patent. [App. at 9a] Indeed, Petitioner's counsel even stipulated at trial that press fits were well known in the art. *Id.* The Federal Circuit then held that the prior art legally precluded Petitioner from asserting infringement under the doctrine of equivalents. *Id.*

In reaching this result the Federal Circuit simply applied this stipulated fact to the well-recognized, often-employed methodology called "hypothetical claim analysis," first delineated in the seminal case of *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684, 14 U.S.P.Q. 2d 1942, 1948 (Fed. Cir.), *cert. denied*, 498 U.S. 992, 111 S. Ct. 537, 112 L. Ed. 2d 547 (1990). [App. at 8a-9a] The Federal Circuit thus found that a "hypothetical claim" that was drafted broadly enough to ensnare the accused structure would not be patentable over the prior art. [App. at 9a] Contrary to Petitioners representations, it was the hypothetical claim and not the actual patent claim that the Federal Circuit analyzed and held to be unpatentable and, therefore, the validity of the actual patent claim was never at issue. Consequently, the Federal Circuit reversed the jury's finding of infringement under the doctrine of equivalents by the CMP2 *as a matter of law.*

REASONS FOR DENYING THE WRIT

I.

THE LIMITING EFFECT OF PRIOR ART ON THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A QUESTION OF LAW

This Court recently reaffirmed the viability of infringement under the doctrine of equivalents in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L. Ed. 2d 146 (1997). However, there are two well-recognized principles which may preclude a patent owner from the application of the doctrine of equivalents. First, the doctrine cannot be used to recapture subject matter that was relinquished by distinguishing the claimed invention over the prior art during prosecution of the patent. 520 U.S. at 31, 117 S. Ct. at 1049-50. This principle is commonly referred to as prosecution history estoppel and was squarely addressed in *Warner-Jenkinson*. The second limiting principle is that the doctrine of equivalents cannot be used to protect subject matter in, or obvious in light of, the prior art. *Athletic Alternatives Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1583, 37 U.S.P.Q. 2d 1365, 1373 (Fed. Cir. 1996); *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684, 14 U.S.P.Q. 2d 1942, 1948 (Fed. Cir.), *cert. denied*, 498 U.S. 992, 111 S. Ct. 537, 112 L. Ed. 2d 547 (1990); *Pennwalt Corp. v. Durand-Wayland*, Inc., 833 F.2d 931, 934, 4 U.S.P.Q. 2d 1737, 1739 (Fed. Cir. 1987) (*en banc*), *cert. denied*, 485 U.S. 961, 108 S. Ct. 1226, 99 L. Ed. 2d 426, 485 U.S. 1009, 108 S. Ct. 1474, 99 L. Ed. 2d 703 (1988). Whether an asserted range of equivalence would encompass what is already in the prior art has always been determined to be a question of law. *Id.*

Indeed, in *Warner-Jenkinson*, this Court acknowledged that these legal limitations on the application of the doctrine of equivalents are issues that a court can determine as a matter of law:

> Of course, the various legal limitations on the application of the doctrine of equivalents are to be ***determined by the court***, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict.

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 39 n.8, 117 S. Ct. 1040, 1053 n.8, 137 L. Ed. 2d 146 (1997), citing Fed. Rule Civ. Proc. 56; Fed. Rule Civ. Proc. 50 (*emphasis added*). Moreover, it is established law that there is no right to a jury trial where there are no issues of material fact to be tried by the jury, so that a proper summary judgment or judgment as a matter of law does not violate the Seventh Amendment. E.g., *Ex parte Peterson*, 253 U.S. 300, 310-11, 40 S. Ct. 543, 546-47, 64 L. Ed. 919 (1920); *Neely v. Martin K. Eby Construction Co., Inc.*, 386 U.S. 317, 322, 87 S. Ct. 1072, 1076, 18 L. Ed. 2d 75 (1967). Thus, under long-standing Federal Circuit and Supreme Court precedent, the Federal Circuit's finding that Petitioner was precluded as a matter of law from asserting the doctrine of equivalents because of the prior art in this action did not deprive Petitioner of its constitutional right to a jury trial.

II.

PETITIONER MISSTATES THE LAW REGARDING WILSON SPORTING GOODS' HYPOTHETICAL CLAIM ANALYSIS

The Petition should also be denied because it is grounded on a misstatement of the law regarding the fundamental distinction between the validity of the claims under 35 U.S.C. § 103 and the limiting effect of prior art on the application of the doctrine of equivalents under the hypothetical claim analysis of *Wilson Sporting Goods*. The difference between these issues was discussed at length by the Federal Circuit in *Wilson Sporting Goods* and exposes the fallacy of Petitioner's reasoning. 904 F.2d at 685, 14 U.S.P.Q. 2d at 1949.

Under 35 U.S.C. § 103, a patent may not be obtained where the differences between an invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art" to which the invention pertains. *Id.* The claims of an issued patent have a strong presumption of validity in infringement proceedings, 35 U.S.C. § 282, and a party challenging validity of a claim must prove by clear and convincing evidence that prior art references would have rendered the invention obvious to one of ordinary skill in the art at the time of invention. *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1323, 50 U.S.P.Q. 2d 1161, 1170 (Fed. Cir. 1999). Thus, an extremely high burden attends any effort to invalidate a patent.

In contrast, the question of infringement presents different issues and a different burden of proof, which as in *Wilson Sporting Goods*, did not require a court to review the jury finding of validity of the asserted claim. 904 F.2d at 686, 14 U.S.P.Q. 2d at 1950. Rather, the issue regarding infringement was whether the prior art restricted the patentee from asserting the doctrine of equivalents. 904 F.2d at 684-85, 14 U.S.P.Q. 2d at 1947-48. In resolving this issue, the Federal Circuit delineated its "hypothetical claim analysis." The Court explained:

> Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a ***hypothetical*** patent claim, sufficient in scope to ***literally*** cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then ***prior art*** is not a bar to infringement under the doctrine of equivalents.

Wilson Sporting Goods, 904 F.2d at 684, 14 U.S.P.Q. 2d at 1948 (*emphasis in original*). Moreover, the burden of proof is drastically different in determining whether the prior art precludes the application of the doctrine of equivalence. As the Federal Circuit noted:

> [T]he burden is on Wilson [the patent owner] to prove that the range of equivalence which it seeks would not ensnare the prior art . . . Leaving this burden on Wilson does not, of course, in any way undermine the presumed validity of Wilson's actual patent claims. In the present situation, Wilson's ***claims will remain valid*** whether or not Wilson persuades us that it is entitled to the range of equivalence sought here.

904 F.2d at 685, 14 U.S.P.Q. 2d at 1949 (*emphasis added*).

Of course, the Federal Circuit has made it clear that this hypothetical claim analysis of *Wilson Sporting Goods* merely is an optional, and not required, methodology for determining the limiting effects of prior art on the application of the doctrine of equivalents. *International Visual Corp. v. Crown Metal Manufacturing Co., Inc.*, 991 F.2d 768, 772, 26 U.S.P.Q. 2d 1588, 1591 (Fed. Cir. 1993). Thus, it is irrelevant whether the Federal Circuit relied upon the optional hypothetical claim analysis, or some other framework for determining the well-settled point of law that the doctrine of equivalents cannot be used to protect subject matter in, or obvious in light of, the prior art. The outcome would have remained the same. *See, e.g., Senmed, Inc. v. Richard-Allan Med. Industrial,* 888 F.2d 815, 821, 12 U.S.P.Q. 2d 1508, 1513 (Fed. Cir. 1989); *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563, 1572, 226 U.S.P.Q. 676, 682 (Fed. Cir. 1985); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1310-11, 46 U.S.P.Q. 2d 1752, 1758 (Fed. Cir. 1998).

As the doctrine of equivalents relates solely to the issue of infringement, the Court's ruling that Petitioner was

precluded from asserting the doctrine of equivalents did not and could not affect the jury's finding of validity of the actual patent claim. The analysis and burdens of proof on validity and infringement are distinct and separate issues. As recognized by this Court in a long line of Federal Circuit precedent, the limitation on the doctrine of equivalents by the prior art is a question of law regardless of the methodology used and, therefore, the Federal Circuit decision reversing the finding of infringement by the CMP2 was appropriate. For this additional reason, Petitioner has not been denied its constitutional right to a jury trial.

CONCLUSION

Petitioner stipulated that the press fit structure of the CMP2 was in the prior art. The Federal Circuit merely applied well-established law in finding as a matter of law that the CMP2 did not infringe the asserted claim under the doctrine of equivalents. The Federal Circuit's decision is not in conflict with the Constitution or any other court decision.

For the reasons stated above, it is respectfully submitted that the Petition for Writ of Certiorari in this matter should be denied.

Respectfully submitted,

KENNETH J. JUREK
McDERMOTT, WILL & EMERY
227 West Monroe Street
Chicago, IL 60606-5096
(312) 372-2000

JAMES R. MULDOON
Counsel of Record
HANCOCK & ESTABROOK, LLP
1500 MONY Tower I
P.O. Box 4976
Syracuse, NY 13221-4976
(315) 471-3151

Attorneys for Respondent
John Mezzalingua Associates, Inc.